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1 COOLEY GODWARD LLP
STEPHEN P. SWINTON (106398)
2 JAMES DONATO (146140)
4365 Executive Drive, Suite 1100
3 San Diego, CA 92121-2128
Telephone: (858) 550-6000
4 Facsimile: (858) 453-3555

5 Attorneys for Plaintiff
Gen-Probe Incorporated
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8 UNITED STATES DISTRICT COURT
9 SOUTHERN DISTRICT OF CALIFORNIA

11 GEN-PROBE INCORPORATED,
12 Plaintiff,
13 v.
14 VYSIS, INC.,
15 Defendant.

No. 99cv2668 H (AJB)

**GEN-PROBE INCORPORATED'S FIRST SET OF
REQUESTS FOR PRODUCTION OF DOCUMENTS
TO VYSIS, INC.**

17 **PROPOUNDING PARTY: GEN-PROBE INCORPORATED**
18 **RESPONDING PARTY: VYSIS, INC.**
19 **SET NUMBER: ONE**

20 Pursuant to Federal Rule of Civil Procedure 34(a)(1), Plaintiff Gen-Probe Incorporated
21 ("Gen-Probe") hereby requests that all documents and tangible things described below be
22 produced for its inspection and/or copying by Gen-Probe in accordance with the Definitions and
23 Instructions set forth below on March 6, 2000 at 10:00 a.m. at the offices of its counsel, Cooley
24 Godward LLP, 4365 Executive Drive, 11th Floor, San Diego, California 92121.

25 **I. DEFINITIONS AND INSTRUCTIONS.**

26 1. VYSIS, YOU, and YOUR mean defendant Vysis, Inc, its directors, officers,
27 employees, attorneys, accountants, consultants, representatives, agents, any parent corporations,

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1 subsidiaries, divisions, successors in interest, any partnerships or joint ventures to which it is a
2 party, and/or other PERSONS acting on its behalf.

3 2. DOCUMENT is used in its broadest sense, and has the same meaning as "documents"
4 as defined in Federal Rule of Civil Procedure 34(a). As used herein, DOCUMENTS includes
5 "things."

6 3. COMMUNICATION means any transmission of information from one PERSON or entity
7 to another by any means.

8 4. PERSON means any natural person and any other cognizable entity, including
9 (without limitation) corporations, proprietorships, partnerships, joint ventures, consortiums, clubs,
10 associations, foundations, governmental agencies or instrumentalities, societies and orders.

11 5. '338 PATENT means United States Patent No. 5,750,338, as well as any and all
12 divisionals, counterparts, continuations, continuations-in-part, or parents thereof, the applications
13 from which any of the foregoing resulted, and any and all other related U.S. and foreign
14 applications.

15 6. LICENSE means that certain Nonexclusive License Agreement Under Vysis' Collins
16 Patents between Gen-Probe and VYSIS, dated June 22, 1999.

17 7. Wherever used herein, the singular shall include the plural and the plural shall
18 include the singular.

19 8. You are to produce the original and each non-identical copy of each DOCUMENT or
20 other tangible thing requested herein which is in your possession, custody or control.

21 9. If you do not produce any DOCUMENT because it is stored electronically or by
22 means of other media, identify such DOCUMENT by the subject matter of the DOCUMENT and the
23 place(s) where such DOCUMENT is maintained, and provide a suitable method for retrieving the
24 DOCUMENT.

25 10. If a request is silent as to the time period for which production of DOCUMENTS and
26 things is sought, you are to produce all DOCUMENTS originated in whole or in part and of all things
27 within your possession, custody, or control at any time during the period December 21, 1987
28 through the date of your production.

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1 **II. DOCUMENTS TO BE PRODUCED.**

2 **REQUEST FOR PRODUCTION NO. 1:**

3 All DOCUMENTS called for by Federal Rule of Civil Procedure Rule 26(a)(1)(B).

4 **REQUEST FOR PRODUCTION NO. 2:**

5 All DOCUMENTS identified in, or relied upon by YOU while preparing, YOUR responses to
6 Gen-Probe Incorporated's First Set of Interrogatories to Vysis, Inc.

7 **REQUEST FOR PRODUCTION NO. 3:**

8 All DOCUMENTS that constitute, evidence or refer to any method or kit for amplifying
9 and/or detecting a target polynucleotide contained in a sample.

10 **REQUEST FOR PRODUCTION NO. 4:**

11 All DOCUMENTS that constitute, evidence or refer to a method or kit for amplifying and/or
12 detecting a target polynucleotide contained in a clinical sample.

13 **REQUEST FOR PRODUCTION NO. 5:**

14 All DOCUMENTS that constitute, evidence or refer to the research and/or development of the
15 methods or kits claimed in the '338 PATENT.

16 **REQUEST FOR PRODUCTION NO. 6:**

17 All DOCUMENTS that constitute, evidence or refer to any and all prior art relevant to the
18 '338 PATENT, including but not limited to any brochures or samples, patents and publications,
19 dated prior to May 3, 1994.

20 **REQUEST FOR PRODUCTION NO. 7:**

21 All DOCUMENTS that constitute, evidence or refer to the '338 PATENT.

22 **REQUEST FOR PRODUCTION NO. 8:**

23 All DOCUMENTS that constitute, evidence or refer to any experiments or research by or on
24 behalf of Mark L. Collins, Donald N. Halbert, Walter King, Jonathan M. Lawrie, Bruce P. Neri,
25 John S. Curtis, and/or Danahey Ryan, concerning any method for amplifying a target
26 polynucleotide contained in a sample and/or sample medium including but not limited to any (1)
27 theses, (2) dissertations, (3) journal articles, (4) lab notebooks, (5) memoranda, (6) handwritten
28 notes, or (7) oral presentation materials.

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1 **REQUEST FOR PRODUCTION NO. 9:**

2 All DOCUMENTS that constitute, evidence or refer to any experiments or research by or on
3 behalf of Mark L. Collins, Donald N. Halbert, Walter King, Jonathan M. Lawrie, Bruce P. Neri,
4 John S. Curtis, and/or Danahey Ryan, concerning any method for detecting a target polynucleotide
5 contained in a sample, and/or sample medium, including but not limited to any (1) theses, (2)
6 dissertations, (3) journal articles, (4) lab notebooks, (5) memoranda, (6) handwritten notes, or (7)
7 oral presentation materials.

8 **REQUEST FOR PRODUCTION NO. 10:**

9 All DOCUMENTS that constitute, evidence or refer to any experiments or research by or on
10 behalf of Mark L. Collins, Donald N. Halbert, Walter King, Jonathan M. Lawrie, Bruce P. Neri,
11 John S. Curtis, and/or Danahey Ryan, concerning any kit for detecting a target polynucleotide
12 contained in a sample, including but not limited to any (1) theses, (2) dissertations, (3) journal
13 articles, (4) lab notebooks, (5) memoranda, (6) handwritten notes, or (7) oral presentation
14 materials.

15 **REQUEST FOR PRODUCTION NO. 11:**

16 All DOCUMENTS that constitute, evidence or refer to any experiments or research by or on
17 behalf of Mark L. Collins, Donald N. Halbert, Walter King, Jonathan M. Lawrie, Bruce P. Neri,
18 John S. Curtis, and/or Danahey Ryan, concerning any kit for amplifying a target polynucleotide
19 contained in a sample, including but not limited to any (1) theses, (2) dissertations, (3) journal
20 articles, (4) lab notebooks, (5) memoranda, (6) handwritten notes, or (7) oral presentation
21 materials.

22 **REQUEST FOR PRODUCTION NO. 12:**

23 All DOCUMENTS that constitute, evidence or refer to the work reported in each of the
24 examples of the '338 PATENT.

25 **REQUEST FOR PRODUCTION NO. 13:**

26 All DOCUMENTS provided by YOU and/or Mark L. Collins, Donald N. Halbert, Walter
27 King, Jonathan M. Lawrie, Bruce P. Neri, John S. Curtis, and/or Danahey Ryan to the patent
28 lawyers who prepared the applications which led to issuance of the '338 PATENT, and all technical

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1 correspondence and COMMUNICATIONS between the inventors and their patent attorneys concerning
2 the preparation of such applications.

3 **REQUEST FOR PRODUCTION NO. 14:**

4 All DOCUMENTS that constitute, evidence or refer to any experimental results, or to any
5 other information submitted to the U.S. Patent and Trademark Office in connection with the
6 prosecution of the '338 PATENT, or information reported to any patent office or other government
7 agency in connection with the prosecution of any related patents or applications, including, but not
8 limited to, (1) records of all work performed, (2) all materials and methods used, and (3) all data in
9 connection with any experiments performed to obtain the results described in such submissions.

10 **REQUEST FOR PRODUCTION NO. 15:**

11 All DOCUMENTS that constitute, evidence or refer to declarations or affidavits submitted to
12 the U.S. patent and Trademark Office in connection with the prosecution of the '338 PATENT.

13 **REQUEST FOR PRODUCTION NO. 16:**

14 All DOCUMENTS that constitute, evidence or refer to the following patent applications:

- 15 a. U.S. Patent Application Serial No. 238,080, filed May 3, 1994;
- 16 b. U.S. Patent Application Serial No. 400,657, filed March 8, 1995
- 17 c. U.S. Patent Application Serial No. 257,469, filed June 8, 1994
- 18 d. U.S. Patent Application Serial No. 124,826, filed September 21, 1993
- 19 e. U.S. Patent Application Serial No. 946,749, filed September 17, 1992
- 20 f. U.S. Patent Application Serial No. 648,468, filed January 31, 1991
- 21 g. U.S. Patent Application Serial No. 644,967, filed January 22, 1991
- 22 h. U.S. Patent Application Serial No. 136,920, filed December 21, 1987
- 23 i. U.S. Patent Application Serial No. 922,155, filed October 23, 1986
- 24 j. U.S. Patent Application Serial No. 944,505, filed September 14, 1992

25 **REQUEST FOR PRODUCTION NO. 17:**

26 All DOCUMENTS, including but not limited to patents and printed publications, that illustrate
27 and/or describe the subject matter of the '338 PATENT.

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1 **REQUEST FOR PRODUCTION NO. 18:**

2 All DOCUMENTS that constitute, evidence or refer to any and all uses by any PERSON of any
3 product or method for the amplification and/or detection of a target polynucleotide contained in a
4 sample prior to May 3, 1994.

5 **REQUEST FOR PRODUCTION NO. 19:**

6 All DOCUMENTS that constitute, evidence or refer to sales, offers for sale, or disclosures by
7 any PERSON of any product or method for the amplification and/or detection of a polynucleotide
8 contained in a sample prior to May 3, 1994.

9 **REQUEST FOR PRODUCTION NO. 10:**

10 All DOCUMENTS that constitute, evidence or refer to any and all uses by any PERSON of the
11 invention of the '338 PATENT with the permission of Mark. L. Collins, Donald N. Halbert, Walter
12 King, and/or Jonathan M. Lawrie prior to May 3, 1994, and any payments made to Mark. L.
13 Collins, Donald N. Halbert, Walter King, and/or Jonathan M. Lawrie for such use.

14 **REQUEST FOR PRODUCTION NO. 21:**

15 All DOCUMENTS that constitute, evidence or refer to the conception of the subject matter
16 claimed in the '338 PATENT, including but not limited to laboratory notebooks, invention
17 disclosures or records of invention, periodic reports, publications, and correspondence.

18 **REQUEST FOR PRODUCTION NO. 22:**

19 All DOCUMENTS that constitute, evidence or refer to the reduction to practice of the subject
20 matter claimed in the '338 PATENT, including but not limited to laboratory notebooks, invention
21 disclosures or records of invention, periodic reports, publications, and correspondence.

22 **REQUEST FOR PRODUCTION NO. 23:**

23 All DOCUMENTS that constitute, evidence or refer to the research and development of the
24 subject matter claimed in the '338 PATENT prior to May 3, 1994.

25 **REQUEST FOR PRODUCTION NO. 24:**

26 All DOCUMENTS that constitute, evidence or refer to any patent application filed in the
27 United States by YOU or by Mark L. Collins, Donald N. Halbert, Walter King, Jonathan M.

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1 Lawrie, Bruce P. Neri, John S. Curtis, and/or Danahey Ryan that describes or claims a method or
2 kit amplification and/or detection, of a target polynucleotide contained in a sample.

3 **REQUEST FOR PRODUCTION NO. 25:**

4 All DOCUMENTS that constitute, evidence or refer to opinions or other COMMUNICATIONS by
5 or to YOU, or by or to any other PERSON, on the issues of infringement, validity, or enforceability
6 of the '338 PATENT, or any other issue relating to the '338 PATENT.

7 **REQUEST FOR PRODUCTION NO. 26:**

8 All DOCUMENTS discussing or analyzing the '338 PATENT and the applications leading
9 thereto, including but not limited to (1) all DOCUMENTS discussing or analyzing the (a) strength, (b)
10 coverage, (c) legal significance, or (d) business significance of the '338 PATENT; (2) the
11 applications leading thereto; or (3) any foreign counterpart patents and applications thereof.

12 **REQUEST FOR PRODUCTION NO. 27:**

13 All DOCUMENTS that constitute, evidence or refer to any license agreement that YOU have
14 entered into, and any royalty that YOU receive or pay or have agreed to receive or pay, with respect
15 to the manufacture, sale, or use of the subject matter claimed in the '338 PATENT.

16 **REQUEST FOR PRODUCTION NO. 28:**

17 All DOCUMENTS that constitute, evidence or refer to any discussion or offer made by YOU
18 to another, or any request or refusal by another, to take a license under the '338 PATENT.

19 **REQUEST FOR PRODUCTION NO. 29:**

20 All DOCUMENTS sufficient to describe assays or kits for the amplification and/or detection
21 of a target polynucleotide contained in a sample, made, sold or offered for sale by YOU or by any
22 of Your licensees that YOU contend are within the claims of the '338 PATENT.

23 **REQUEST FOR PRODUCTION NO. 30:**

24 A sample of each of the assays or kits for the detection of a target polynucleotide contained
25 in a sample made, sold or offered for sale by YOU or by any of YOUR licensees that YOU contend
26 are within the claims of the '338 PATENT.

27 **REQUEST FOR PRODUCTION NO. 31:**

28 All DOCUMENTS submitted to the Food and Drug Administration or other governmental

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1 regulatory agency for the purpose of obtaining licensing or approval of products that YOU contend
2 are within the claims of the '338 PATENT.

3 **REQUEST FOR PRODUCTION NO. 32:**

4 All DOCUMENTS that constitute, evidence or refer to efforts by others to invent the subject
5 matter claimed by the '338 PATENT at any time prior to May 3, 1994.

6 **REQUEST FOR PRODUCTION NO. 33:**

7 All DOCUMENTS that constitute, evidence or refer to any ownership interest formerly
8 possessed, now possessed, or to be acquired by any PERSON, entity, or institution in the subject
9 matter claimed in the '338 PATENT, whether arising by virtue of inventorship, assignment, license,
10 security interest, lien, or any other direct or beneficial interest, including but not limited to all
11 DOCUMENTS that constitute, evidence or refer to any actual or proposed assignment, license, or
12 other disposition of right, title, or interest in the subject matter of the '338 PATENT.

13 **REQUEST FOR PRODUCTION NO. 34:**

14 All DOCUMENTS that constitute, evidence or refer to COMMUNICATIONS between YOU and
15 present or former Gen-Probe employees, agents or representatives regarding the '338 PATENT or
16 methods for amplifying and/or detecting target polynucleotides.

17 **REQUEST FOR PRODUCTION NO. 35:**

18 All DOCUMENTS that constitute, evidence or refer to YOUR document retention or
19 destruction policies.

20 **REQUEST FOR PRODUCTION NO. 36:**

21 Corporate organization charts sufficient to identify YOUR organization structure generally
22 and as it relates to the following functions as they relate to the subject matter claimed in the '338
23 PATENT: (a) research and development; (b) patents; (c) licensing; (d) manufacturing; (e)
24 distribution; (f) marketing and sales; and (g) strategic planning.

25 **REQUEST FOR PRODUCTION NO. 37:**

26 All publications authored by each PERSON that YOU intend to offer as an expert witness and
27 all DOCUMENTS that YOUR or any PERSON acting on YOUR behalf has shown or otherwise made the
28 contents of available to any such expert.

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REQUEST FOR PRODUCTION NO. 38:

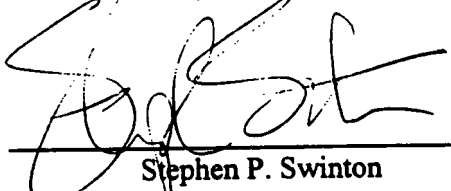
All publications authored or co-authored by YOUR, Mark L. Collins, Donald N. Halbert, Walter King, Jonathan M. Lawrie, Bruce P. Neri, John S. Curtis, and/or Danahey Ryan that refer to or evidence a method or kit for the amplification and/or detection of a target polynucleotide contained in a sample.

REQUEST FOR PRODUCTION NO. 39:

All DOCUMENTS that constitute, evidence or refer to speeches or other presentations by YOU, Mark L. Collins, Donald N. Halbert, Walter King, Jonathan M. Lawrie, Bruce P. Neri, John S. Curtis, and/or Danahey Ryan, relating to a method or kit for the amplification and/or detection of a target polynucleotide contained in a sample including but not limited to any files or notes about such speeches or presentations, any and handouts given to the persons to which the speech or presentation was made.

Dated: February 3, 2000

COOLEY GODWARD LLP
STEPHEN P. SWINTON (106398)
JAMES DONATO (146140)

By: 
Stephen P. Swinton

Attorneys for Plaintiff
Gen-Probe Incorporated